



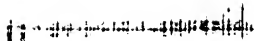
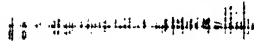
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/718,238 | 11/19/2003 | Thomas Viebach | 03213616 | 9908 |
| 26565 | 7590 | 06/14/2006 | EXAMINER | |
| MAYER, BROWN, ROWE & MAW LLP P.O. BOX 2828 CHICAGO, IL 60690-2828 | | | KASZTEJNA, MATTHEW JOHN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/718,238

Applicant(s)

VIEBACH ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9, 11, and 12 is/are rejected.
- 7) ☒ Claim(s) 6-8, 10, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on March 27, 2006, amended claims 1, 6 and 9 and canceled claims 4-5 are acknowledged. The current rejections of claims under 35 U.S.C 102(a) to Hirano are *stand*. The following new and reiterated grounds of rejection are set forth:

Claim Objections

Claim 1 objected to because of the following informalities: The term "or the like" in claim 1 is a relative term which renders the claim indefinite. The term "or the like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 9, 11 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Hirano (U.S. Patent No. 6,447,445).

In regard to claims 1-3, 9, 11 and 12, Hirano teaches an endoscope comprised of an operation unit 1, an insertion instrument 2 and a universal cord 3 (see figure 1). The insertion instrument 2 has a hard end portion 2a at its distal end and the hard end

Art Unit: 3739

portion 2a is formed of a holding member 40 and a cover member 41 where concave-shaped recesses 42, 43 and 44 are formed at three positions in the holding member 40 (see Figures 2 and 4). An illumination lens barrel 13, an objective lens barrel 24 and a treating tool inserting pipe 32 are respectively fitted into the recesses 42, 43 and 44 (see Figure 2). Recesses 42, 43 and 44 have openings for introductory part 42a, 43a and 44a and receptors 42b, 43b and 44b for correctly placing the illumination lens barrel 13, objective lens barrel 23 and treating tool inserting pipe 32 (see Figure 4). Cover member 41 fits to the external peripheral surface of the holding member 40 and consequently the illuminating lens barrel 13, objective lens barrel 24 and treating tool inserting pipe 32 are restricted in the axial direction (see col. 5, lines 35-50).

Allowable Subject Matter

Claims 6-8, 10, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed March 27, 2006 have been fully considered but they are not persuasive.

Applicant states that there is no mounting adapter comprising all connection for connecting the conduits and/or passages of the endoscope shaft with the function-related units of the head. Firstly, as broadly as claimed, mounting adapter 40 is adapted to provide or enable all connections between passages 10, 20 and 30 formed in the endoscope shaft and the function-related units 13, 24 and 32 of the endoscope

(see Fig. 4). Secondly, the words "adapted to" and "enable" in the claim may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein the head is completely mounted separately from the shaft) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

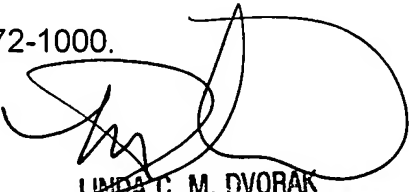
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700